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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,008	12/10/2003	Richard D. Bunch	HSJ9-2003-218-US1	9413
23980	7590	07/17/2007		
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C			EXAMINER	
1400 PAGE MILL ROAD			GOFF II, JOHN L	
PALO ALTO, CA 94304-1124				
			ART UNIT	PAPER NUMBER
			1733	
			MAIL DATE	DELIVERY MODE
			07/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/734,008	Applicant(s) BUNCH ET AL.	
	Examiner John L. Goff	Art Unit 1733	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-26.
Claim(s) withdrawn from consideration: 27-34.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


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Continuation of 11. does NOT place the application in condition for allowance because:

The evidence filed after the Final Rejection mailed 4/2/07 will not be entered because applicant failed to provide a showing of good and sufficient reasons why the evidence was not earlier presented. The amendment would be entered if resubmitted separately from the evidence.

It is also suggested applicants next amendment change the dependency of claim 23 from 23 to 19.

Applicants argue, "As an initial matter, the Applicants note that the Office has rejected Claims 1, 5, 6, 8-10 and 12-14 over Ruiz and Asami in view of Tanaka (Item 10, page 7). As this rejection was neither advanced in the prior Office Action nor necessitated by the Applicants amendments to the claims, this rejection amounts to a new ground of rejection. According to the M.P.E.P. § 706.07 (a), a final rejection is not proper where a new ground of rejection is introduced in this manner. Consequently, the Applicants respectfully request that the finality of this rejection be removed."

Applicants amended claim 6 in the reply filed 12/22/06 wherein Ruiz in view of Asami et al. and Tanaka et al. was set forth to address the amendment. Accordingly the new rejection of claim 6 also was applicable to claims 1, 5, 8-10, and 12-14. In view of applicants objection the rejection of claims 1, 5, 8-10, and 12-14 over Ruiz in view of Asami et al. and Tanaka et al. is withdrawn. However, claim 6 remains rejected over Ruiz in view of Asami et al. and Tanaka et al. which rejection was made specifically in view of applicants amendment and was not a new ground of rejection.

Applicants further argue, "Hacker does not anticipate Claim 19 because Hacker does not teach an adhesive composition that excludes solvents having boiling points above about 80° C. Rather, Hacker discloses ethyl lactate as a representative solvent. See paragraph 18. As can be seen with reference to Exhibit A, ethyl lactate has a boiling point of about 155° C. Accordingly, Hacker does not teach all the elements of the rejected claims and consequently does not anticipate the claimed invention. The Applicants, therefore, respectfully request that this rejection be withdrawn."

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As set forth in the Final Rejection, Hacker et al. teach an adhesive composition of a resist adhesive resin and a solvent having a boiling point within the range claimed the composition does not include, i.e. the composition excludes, solvents having boiling points above about 80 °C. Hacker et al. anticipates claims 19 and 21. The same is true for Uetani et al. and Teiichi et al.

Applicant further argues, "Therefore, as can be seen with reference to the above, it is not the solvent in the adhesive that gives it the "excellent heat and moisture resistance with no volatilization" properties, but rather the particular phenolic resin disclosed. Accordingly, using the motivation of the Office, at best one of skill in the art would be motivated to use the particular phenolic resins disclosed in Teiichi as part of the thermo-plastic temporary adhesive of Ruiz, and not a resist adhesive resin and a solvent as claimed by the Applicants. For this reason alone this rejection may be withdrawn."

As set forth in the Final Rejection, Teiichi et al. disclose a thermoset adhesive composition including thermoset adhesive and solvent which composition has excellent heat and moisture resistance with no volatilization wherein it would have been obvious to use the adhesive composition, i.e. thermoset adhesive and solvent, to adhere the ceramic chunk to the ceramic manufacturing tool in Ruiz for this reason.

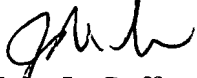
Applicants further argue, "According to M.P.E.P. § 2144.08, the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness. Rather, the Federal Circuit has declined the rule that regardless of how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it. Therefore, in establishing a *prima facie* case of obviousness, Office personnel should determine whether one of ordinary skill in the relevant art would have been motivated to select the claimed species or subgenus from the disclosed prior art genus."

Teiichi et al. is applied as an express disclosure of an acetone solvent (which has a boiling point within the claimed range), i.e. Teiichi et al. expressly discloses the claimed species

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in contrast to a reference which discloses a genus encompassing the claimed species or subgenus

but does not expressly disclose the claimed species.

A handwritten signature in black ink, appearing to read 'J. L. Goff', written in a cursive style.

John L. Goff

Primary Examiner

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